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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>P1715US00</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number <b>09/862,766</b>	Filed <b>5/21/2001</b>
on _____		First Named Inventor <b>VOSSLER, STEPHEN P.</b>	
Signature _____		Art Unit <b>2656</b>	Examiner <b>NEYZARI, ALI</b>
Typed or printed name _____			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		 Signature <b>JEFFREY A. PROEHL</b> Typed or printed name <b>(605) 232-1967</b> Telephone number <b>JAN 18, 2006</b> Date	
<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>35,987</b> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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### MEMO IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1 through 19 and 21 through 24 have been finally rejected under 35 U.S.C. §103(a) as being unpatentable over Mauney et al. (US 5,659,156) (hereinafter "Mauney") in view of PCT Application No. WO 00/75924 of Woo (hereinafter "Woo").

As noted in the previous response, claim 1 requires "an ear module formed to be *entirely supported* by an ear". Claim 4 requires "an ear module formed to be *entirely supported* by an ear". Claim 9 requires "an ear module formed to be *entirely supported* by an ear". This relationship, which is evidenced by the Figures of the drawings, permits the ear module to be worn without requiring other contact or connections with the body of the wearer.

The rejection of the claims is based upon the allegedly obvious combination of the device of the Mauney patent with selected aspects of the device of the Woo application, as it appears to be conceded in the Office Action that the Mauney device is limited in function, since it is alleged in the rejection that:

Mauney et al disclose the claimed invention except for the components such as memory for storing digitized audio and a player.

It is contended in the rejection that the Woo application makes up for the defects in the Mauney patent:

PCT, WO 00/75924, disclose a portable audio player suitable for use for an MP3 player. The audio player comprises of an ear module (4) to be supported by an ear (Fig 3). The module includes a speaker (130), a memory for storing digitized audio (F), a D/A converter (120), and micro processor (100) (Fig 6) (page 5, lines 18-25, page 7, lines 16-21).

The alleged motivation for this combination between the device of the Mauney patent and the selected features of the Woo application is stated in the Office Action (emphasis added):

It would have been obvious to one of ordinary skill in the art to use the portable audio player as disclosed in the PCT '924, in the ear mold of Mauney et al in order to have the ear module entirely supported by an ear, wherein the ear module being free of any other structure providing support on the body of a user when supported on the ear (as claimed in new claims 22-24).

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However, since the Mauney device is already allegedly "entirely supported by an ear", it is not understood why one of ordinary skill in the art, considering the Mauney patent, would look to the Woo application for any modification of the Mauney device for such a purpose. Indeed, this statement of motivation appears to be more consistent with an obviousness rejection in which the Woo publication is considered to be the primary reference, and the Mauney patent is the secondary reference suggesting modification of the primary reference. However, as the rejection is stated, it is asserted that one of ordinary skill in the art, considering the Mauney patent, would have allegedly found it obvious to modify the Woo device.

In any event, for the following reasons, it is submitted that one of ordinary skill in the art would not have found it obvious to modify the Mauney device with the "a memory for storing digitized audio" and "a player coupled to the speaker, battery and memory that provides audio signals to the speaker based on the digitized audio".

Firstly, the Mauney patent discusses a device that functions as a hearing aid by detecting environmental sounds through a microphone and reproducing those detected sounds through a speaker, presumably at a louder volume, as soon as possible after the sound has been detected. One of ordinary skill in the art, considering the Mauney patent, recognizes that the Mauney hearing aid device does not include, and does not need to include, any capability for storing information because it needs to immediately reproduce the sounds that have been detected. In fact, any delay in the reproduction of the detected sound is undesirable, as this would put the user of the Mauney hearing aid device at a disadvantage. Thus, it is submitted that one of ordinary skill in the art would not recognize any benefit from, or purpose for, providing the Mauney device with "memory", as all sounds detected by the Mauney device need to be reproduced as soon as possible so that the user is made aware of the sounds as close to "real time" as possible.

Secondly, there would be no reasonable benefit for providing the hearing aid device of Mauney with a player for playing sounds stored in the memory, as this function would only interfere with the function of amplifying environmental sounds of the Mauney hearing aid.

Thirdly, one of ordinary skill in the art would recognize that any attempt to add the memory and player of Woo to the Mauney hearing aid device would simply increase

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the weight and bulk of the hearing aid device while adding functions that, at best, are superfluous to the hearing aid function, and, at worst, would hamper the hearing aid function of the Mauney device.

Further, nothing in the Mauney patent or Woo application suggests to one of ordinary skill in the art that a hearing aid would benefit from having a memory and a player of digitized audio. Similarly, nothing in the Mauney or Woo documents state that the Woo device would benefit from an "entirely supported by the ear" configuration, as the ear phones of Woo still need to be connected together to play the audio as stereo sounds, with one channel being directed into each of the ears of the user. This function is not required in the Mauney hearing aid device, as each the hearing aid device of each ear needs to reproduce the sounds of its own environment. But the Woo device requires a connection between the ear phones to deliver the signal to each of the ear phones, and it is not clear from the Woo publication or the rejection how these ear phones would be connected together while still being "entirely supported by an ear". It is submitted that any physical connection between the earphones of Woo would inevitably rest against the body. The Mauney patent does not disclose to one of ordinary skill in the art any way of connecting two ear pieces together that would avoid contacting, and gaining support from, the body of the user, particularly the head of the user.

It is therefore submitted that one of ordinary skill in the art would not find it obvious to combine the device of the Mauney patent with the device of the Woo PCT application, and thus would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claims 1, 4, and 9, especially with the requirements set forth above, and therefore it is submitted that these claims are allowable over the prior art. Further, claims 2, 3, 5 through 8, and 10 through 13, which depend from these claims, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Claims 14 and 16 each require "a connector adapted to connect to the audio player *in a suspended relationship from the audio player*" and "a memory coupled to the connector that stores digitized audio, *the memory being suspended from the connector to suspend the memory from the audio player*". Claim 18 requires "storing such digital

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format signals on a memory device” and “suspending the memory device from a digitized audio player entirely supported by an ear of a user of the player”.

The rejection of the Office Action fails to identify *any* structure in either of the cited documents that would show the suspended relationship set forth in these claims, and it is submitted that neither of the cited documents discloses such a relationship.

In fact, in contrast to the requirements of these claims, the Woo PCT application discloses a flash memory device F that is *inserted into* the “main body” of the device that extends around the back of the head of the user. Clearly, this flash memory is not suspended in any manner, as it is positioned inside the relatively rigid strap of the main body. This point, made in the previous response, was not disputed in the final rejection.

It is therefore submitted that the Mauney patent and the Woo PCT application would not lead one of ordinary skill in the art to the applicant’s claimed invention as defined in claims 14, 16 and 18, especially with the requirements set forth above, and therefore it is submitted that these claims are allowable over the prior art. Further, claims 15, 17, 19, and 21, which depend from these claims, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 1 through 19 and 21 through 24 is therefore respectfully requested.